

REMARKS/ARGUMENTS

The Applicants' representative has reviewed the Examiner's Office Action of November 21, 2006, in which the Examiner rejected claims 1-31 as being unpatentable over U.S. Patent No. 6,158,330 to Andress ("Andress") in view of U.S. Patent No. 2,253,834 to Volks ("Volks").

The Examiner has taken the position that Andress discloses all of the limitations of claims 1-31 except for the gas burner. The Examiner relies upon Volks for its purported disclosure of gas burner pipes arranged beneath an energy receiving portion such that the energy receiving portion is 'directly above' the gas burner. For the reasons provided below, the Applicants believe that Examiner's rejections are flawed.

There is no motivation to combine Andress and Volks:

First, there is no motivation to combine Andress and Volks as they are configured for use with heat sources having substantially different structure. The Examiner points out that Andress expressly provides at col. 1, lines 12-15 that the invention "may be used with barbecue grills having a heating source underneath or laterally of said cooking grid." By referring to a barbecue grill having a heating source underneath or laterally of said cooking grid, the Applicants believe that Andress was referring specifically to the type of barbecue grill which is disclosed by US Patent No. 6,182,560 ("the '560 patent"), the specification of which was incorporated into Andress. (See col. 2, lines 14-18 incorporating application serial number 09/332,903). The '560 patent teaches a heat source which is generally vertically aligned, whereby the heat source is disposed lateral to the cooking grid at a rear side of the grid. Although a portion of the heat source disclosed in the '560 patent is technically "underneath" the grid (i.e., the bottom of the heat source has an elevation which is lower than that of the cooking grid), the heat source is not

directly underneath as called for by claims 1 and 27. Moreover, given the vertical configuration of the Address heat source, the grid will not be directly exposed to a flame as called for by claim 11.

The Applicants expect the Examiner to respond that the above mentioned limitations are taught by Volks. However, the cooking grid of Volks is designed for use with a barbecue grill having a horizontally oriented heat source which has a substantially different structure than the vertical heat source of Address. Given the specific use for which Address is designed, there is no motivation to combine Volks with Address because the Examiner's proposed modification of the Address cooking grid would change its principle of operation. See MPEP Section 2143.01. The CCPA held in *In re Ratti*, 270 F.2d 810, 8813 (CCPA 1959) that a proposed combination is improper if the "suggested combination of references would require a substantial reconstruction and redesign of the elements shown in [the primary reference] as well as a change in the basic principle under which the [primary reference] construction was designed to operate." The cooking grid of Address is designed to work in conjunction with a vertically aligned heat source and a grease tray which is disposed directly underneath the grid. The positional relationship of the grease tray and the cooking grid is permitted due to the fact that the heat source is laterally displaced from the grid in a vertical position. To incorporate the horizontally aligned burner tubes of Volks into Address, as suggested by the Examiner, would interfere with the grease control system of Address and would require relocation of the grease tray. For this and other reasons, the modifications proposed by the Examiner would require substantial redesign and reconstruction of the Address cooking grid and grease tray. Therefore, the Applicants respectfully request the Examiner to withdraw the rejections of claims 1-31.

Andress does not disclose an energy receptor portion (or energy receptor plane):

Second, the Applicants fail to see how the Examiner equates the troughs 13 of Andress with the energy receptor portion of the claims. Neither Andress nor Volks suggest that the troughs should be configured as such. As discussed above, Andress contemplated that the grid would be used in conjunction with a vertical heat source. As such, the troughs 13 would not be positioned in close proximity to the heat source as called for by claims 1, 11 and 27, and therefore could not be considered to be energy receptor portions. The Applicants fail to see how Volks suggests using the grease troughs of Andress as energy receptor portions. Therefore, the Applicants respectfully request withdrawal of the rejections of claims 1-31 or an explanation of how the Examiner came to the conclusion that the troughs were energy receptor portions.

The Examiner improperly uses double inclusion to reject claims 1, 14, and 27:

Third, the Examiner improperly uses double inclusion to reject claims 1, 14 and 27. These claims call for the cooking grate to include **both** cooking members and a solid energy receptor portion, whereby the cooking members depend from the energy receptor portion. The Examiner contends that the grid members 31 of Volks are energy receiving portions. Yet, the Examiner's rejection ignores the fact that the grid members 31 are the cooking members. The Examiner's rejection therefore relies upon a single element (the grid members 31) for its assertion that two clearly separate claim elements are found in the prior art. The claims 1 and 27 clearly set forth that the cooking members are not the solid energy receptor portions, as the cooking members are said to depend from the energy receptor portion. Therefore, the Examiner's rejection of claims 1, 14, and 27 is improper and should be withdrawn.

Claims 2, 10 and 16-20 recite parameters which are not merely design choices

Third, the Examiner improperly rejects claims 2, 10 and 16-20 on the basis that adjusting the mass distribution of the grate or the size of the openings is simply a matter of optimizing the mass of the grate and slot sizes of Address as desired through routing experimentation. To support this rejection, the Examiner refers the Applicants to MPEP 2144.04(II)(A). However, this section is inapposite to the Examiner's position as it states that *omission* of an element from a prior art reference is obvious if the function of the element is not desired. Here, the Applicant can be said to be *adding* an element to the prior art by changing the mass distribution and opening sizes of the prior art. The opening sizes and the mass distribution do add to the patentability of claims 2, 10, 16-20 as the specific parameters recited in these claims allow for more even heat distribution and more uniform cooking than the cooking grids of the prior art. For this reason, the Applicants respectfully request withdrawal of the Examiner's rejections of claim 2, 10, and 16-20.

Neither Address nor Volks disclose a lower grease control structure:

The Examiner claims that Address shows an upper sloped grease control structure configured on the upper surface of the receptor portion by citing the slopes of the sides of member 17 and a lower grease control portion that includes an apex located below the cooking surface by citing the apexes formed between the troughs 18. The Applicants strongly disagree with the Examiner's characterization of Address as having the claimed upper and lower grease control portions for various reasons. Nevertheless, the Applicant notes that the Examiner has failed to assert that the cited prior art discloses a ridge depending from the lower surface of the lower grease control structure, as called for by claims 6, 24, and 30. Moreover, the Examiner

fails to show how Andress and/or Volks teach (1) that the lower grease control structure is positioned past an extent of the gas burner below the cooking grate to prevent grease from draining onto the burner flame region of the gas burner, as called for by claims 7 and 31 or (2) that the lower grease control structure is positioned on the cooking grate to prevent grease from draining into the burner flame region, as recited in claim 25. Therefore, the Applicants respectfully request the Examiner to withdraw his rejection of claims 6, 7, 24, 25, 30, and 31.

Claim 11 is amended to further distinguish claims 11-26 from the prior art

Notwithstanding the above, the Applicants hereby amend claims 11-15 to further distinguish the claims from the Andress and Volks. Claim 11 is amended to require the gas burner to be comprised of two gas burner sections which are aligned generally transverse to each other. Moreover, the energy receptor plane has two sections which are generally parallel to the gas burner sections. Thus, both the gas burner and the energy receptor plane have lengths which extend in two dimensions, which presents problems which were not contemplated or solved by Andress or Volks. For the above reasons, the Applicants respectfully request that the Examiner withdraw the rejection to claims 11-26.

Conclusion:

For the foregoing reasons, the Applicants believe that the claims are sufficiently distinguished from the prior art and are in condition for allowance.

The Applicant believes that no fees are required for submission of this document.
In the event that the Applicant is mistaken, you are hereby authorized to deduct the any required amounts from our Deposit Account No. 02-0400 (Baker & McKenzie). *When identifying such a withdrawal, please use the Attorney Docket Number WEB-954.*

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Respectfully,

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